

## **Remarks**

### **Specification Objections**

The examiner has objected to the disclosure that the continuation data section is not filled out properly. Applicant has amended the disclosure to incorporate Examiner's suggested corrections.

### **Claim Objections**

The Examiner objected to claims 1-27, 28-31, 40, and 41 for various informalities. Applicant has amended the claims to incorporate Examiner's suggested corrections.

### **Claim Rejections – 35 USC § 112**

The Examiner objected to claims 1-27, 29, 40, and 41 under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 1 to incorporate Examiner's suggested corrections. Claims 2-27, 29, 40 and 41 depend, either directly or indirectly, on independent claim 1. For the reasons claim 1 is patentable, applicant respectfully suggests that claims 2-27, 29, 40 and 41 are also patentable.

### **Claim Rejections – 35 USC § 103(a)**

The Examiner has cited United States Patent No. 5,897,262, issued to Mary Bratby-Carey, against claims 1-27, 29, and 40-49 of the present application, under 35 U.S.C. 103(a) as being obvious in view of United States Patent No. 5,937,866, issued to Laila Magharehi, and United States Patent No. 6,276,856, issued to Kathleen Ann Pieper. Applicant has amended claim 1 to better distinguish the present invention from the above cited prior art. For example, claim 1 now covers a dual ended container with a first receptacle with a threaded neck portion

extending from its body portion, and a rim extending from the neck, and a roller ball seated firmly in the rim by means of a spring to prevent essential oils and/or moisture from escaping from the receptacle. Brabty-Cary discloses a nail polish application and removal device. See col. 1 lines 5-6. In figure 3, Brabty-Cary discloses a nail polish removal container with a sponge applicator assembly that snap fits into the opening. See col. 3 lines 13-22. The present applicant and Brabty-Cary are structurally distinct because unlike in Brabty-Cary, the present application prevents the substance in the reservoir from escaping by seating a rollerball in the rim of the first receptacle. See claim 1. In Brabty-Cary, the sponge applicator assembly snap fits into the open end of the receptacle and is not restricted by a rim. See col. 3 lines 13-22.

Applicants respectfully submit that Magharehi's disclosure of compositions of hair dye applicator in view Brabty-Cary does not make the present application unpatentable. Magharehi discloses hair dye applicator with a removable roller ball applicator. See col. 3 lines 5-10. Magharehi explains that the roller ball is loosely confined. See col. 3 lines 5-10. Thus, the roller ball in Maghaerhi is not firmly seated as in applicant's claimed invention.

Claims 2-27, 29, and 40-41 depend, either directly or indirectly, on independent claim 1. For the reasons claim 1 is patentable, applicant respectfully suggests that claims 2-27, 29, and 40-41 are also patentable.

Applicant has amended claim 42 to better distinguish the present invention from the above cited prior art. For example, claim 42 now covers a dual ended container with a roller ball applicator with a roller ball seated firmly in the rim by means of a spring to prevent essential oils and/or moisture from escaping from the receptacle. Brabty-Cary discloses a nail polish application and removal device. See col. 1 lines 5-6. In figure 3, Brabty-Cary discloses a nail

polish removal container with a sponge applicator assembly that snap fits into the opening. See col. 3 lines 13-22. The present applicant and Brabty-Cary are structurally distinct because unlike in Brabty-Cary, the present application prevents the substance in the reservoir from escaping by seating a rollerball in the rim of the first receptacle. See claim 42. In Brabty-Cary, the sponge applicator assembly snap fits into the open end of the receptacle and is not restricted by a rim. See col. 3 lines 13-22.

Applicants respectfully submit that Magharehi's disclosure of compositions of hair dye applicator in view Brabty-Cary does not make claim 42 of the present application unpatentable. Magharehi discloses hair dye applicator with a removable roller ball applicator. See col. 3 lines 5-10. Magharehi explains that the roller ball is loosely confined. See col. 3 lines 5-10. Thus, the roller ball in Magharehi is not firmly seated as in applicant's claimed invention.

Claims 43-49, depend, either directly or indirectly, on independent claim 42. For the reasons claim 42 is patentable, applicant respectfully suggests that claims 43-49 are also patentable.

#### **Objective Evidence of Nonobviousness**

According to MEP 716.01(a), Affidavits containing evidence of commercial success must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 USC § 103(a). An applicant must show that the claimed features were responsible for the commercial success of an article. See In re Huang, 100 F.3d 135, 140 (Fed. Cir. 1996).

Applicant respectfully submits that the submitted 132 affidavit demonstrates commercial success with products which embody the present invention. Since its introduction in 2001, applicant has sold over 7.5 million applicator packages which are embodiments of the present

invention. See lines 19-20 of the 132 affidavit. Commercial success of applicant's invention can also be seen by a close examination of the sales figures from year to year. For example, in 2006 applicant sold 466,200 packages and 717,000 packages in 2007. See line 20 of the 132 affidavit. Applicant's sales increased again to 2,218,600 packages in 2008, and 363,000 packages in only the first two months of 2009. See line 20 of the 132 affidavit. Even in these difficult economic times these are substantial sales of the subject matter of the present invention.

Applicant respectfully submits that the commercial success of the packages which embody the present invention is because of its claimed features. It is an object of the present invention to provide a cosmetic container that occupies less space in a purse or bag. See paragraph 0007. It is another object of the present invention to provide a combination package for carrying two or more cosmetic products preferably different cosmetics products in a single package. See paragraph 0008. And it is exactly these features which have caused major publications to recommend products which embody applicant's invention. For example, Seventeen Magazine ran an article entitled "Wallet Size Lip Gloss, Clump Free Mascara and More I Gotta-Have-Em Tidbits by Laura Kinney." in which the author highlighted the numerous uses of the applicant's invention and characterized it as a "bang for your buck". See exhibit 8. Allure Magazine's editors selected applicant's invention as one of their favorite cosmetic items, and cited its ability to carry multiple cosmetic products. See exhibit 11. Lucky Magazine also mentioned a product which embodied applicant's invention as one it's "miracle workers" and highlighted its ability to store multiple cosmetic products. See exhibit 10. Applicant has no relationship with Allure, Seventeen, or Lucky Magazine, and had no input to the content of the cited articles.

CONCLUSION

For the foregoing reasons, Applicant requests reconsideration of the rejection.

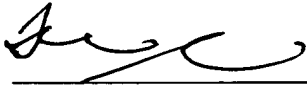
Respectfully submitted,



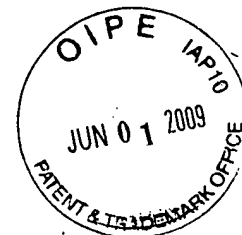
Thomas A. O'Rourke  
Reg. No.: 27,665  
Bodner & O'Rourke, LLP  
425 Broadhollow Road  
Melville, NY 11747

CERTIFICATE OF MAILING

I hereby certify that the foregoing Response was mailed by first class mail,  
postage prepaid, in an envelope addressed to the Commissioner for Patents  
P.O. Box 1450 Alexandria, VA 22313-1450 on this 29<sup>th</sup> day of May, 2009.



Thomas A. O'Rourke



If any additional fees are due or an overpayment has been made; please charge Deposit

Account No. 50-3070, or credit our deposit account for such sum.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thomas A. O'Rourke".

Thomas A. O'Rourke  
Reg. No.: 27,665  
BODNER & O'ROURKE, L.L.P.  
425 Broadhollow Road  
Melville, NY 11747  
(631)249-7500